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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,094	06/01/2001	Travis J. Parry	10005949-1	3103

7590

06/21/2005

HEWLETT-PACKARD COMPANY  
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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,094

Applicant(s)

PARRY ET AL.

Examiner

James W. Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on April 14, 2005 is sufficient to overcome the Weinblatt (5,401,946) reference. The amendment amended Claims 1, 10, and 12. No claims were canceled and no new claims were added. Therefore, the currently pending claims considered below remain Claims 1-36.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

On page 6, line 5, the word "holding" should be changed to "hold".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. The amendment filed on April 14, 2005 has overcome the rejection of Claims 1-2, 5-8, 10-13, and 15 in paragraph 2 of the January 19, 2005 Office Action as being directed towards non-statutory subject matter by adding technological devices to the independent method claims. Therefore, the Examiner hereby withdraws that rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3622

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-5, 7-13, 16-22, 25, 27-29, and 31-34 are rejected under 35

U.S.C. 102(e) as being anticipated by Sato et al (US2001/0037267).

Claims 1, 10, 12, 13, 17, 18, 25, and 33: Sato discloses a method, apparatus, and program for promoting the use of consumables, comprising:

- a. detecting consumption of one or more consumables in one or more imaging devices using a consumption detecting device (page 4, paragraphs 0079, 0080, and 0098; page 6, paragraph 0119; page 7, paragraph 0125; and page 8, paragraph 0136);
- b. rewarding the user of the imaging device(s) when the consumption of a predefined quantity has been reached (Figure 16); and
- c. Notifying the user of the reward by displaying a reward message on the display (Figure 16).

Claims 3, 19, 20, 27, and 34: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 17, 25, and 33 above, and further discloses receiving the reward certificate through a global computer network connection (Figure 2; page 4, paragraph 0098; and page 11, paragraphs 0181-0182).

Claims 4 and 28: Sato discloses a method and program for promoting the use of consumables as in Claims 3 and 27 above, and further discloses that receiving the reward over the global computer network is performed automatically upon reaching the predetermined usage level of the consumable (page 11, paragraphs 0181-0182).

Claims 5 and 29 Sato discloses a method and program for promoting the use of consumables as in Claims 1 and 25 above, and further discloses calculating an estimated consumption of the consumable (pages 9-10, paragraphs 0162-0174).

Claim 7: Sato discloses a method for promoting the use of consumables as in Claim 1 above, and explicitly discloses the consumable having a standard price and the user reward is a discount (percentage off) over the standard price (Figure 16).

Claims 8, 21, and 31: Sato discloses a method apparatus, and program for promoting the use of consumables as in Claims 1, 17, and 25 above, and further discloses counting the sheets of consumable media (e.g. paper)(page 7, paragraph 0125 and page 8, paragraph 0136).

Claims 9, 22, and 32: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 17, and 25 above, and further discloses calculating the amount of image forming substance (e.g. toner) consumed by the imaging device (page 4, paragraph 0098 and page 6, paragraph 0119).

Claims 11 and 16: Sato discloses a method for promoting the use of consumables as in Claims 10 and 12 above, and further discloses basing the value of the reward on the value of the individual consumable (by rewarding a percentage of the consumable's cost)(Figure 16).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 14, 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US2001/0037267) in view of Weinblatt (5,401,946).

Claims 2, 14, 26, and 36: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 12, 25, and 33 above, but does not explicitly disclose that the reward is a coupon printed on the imaging device. However, Weinblatt discloses a similar method, apparatus, and program for promoting the use of consumables in which a coupon is printed as a reward for reaching a predetermine usage level of the consumable (col 13, line 67 – col 14, line 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print a coupon on the imaging device being monitored in Sato. One would have been

Art Unit: 3622

motivated to print the coupon in order to allow the user to receive the earned reward when purchasing replacement consumables at local physical stores.

8. Claims 6, 15, 23, 24, 30, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US2001/0037267) in view of Wegman et al (6,418,283).

Claims 6, 15, 23, 24, 30, and 35: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 12, 17, 25, and 33 above, but does not explicitly disclose identifying the source of the consumable and basing the reward on the identified source. However, Wegman discloses a similar method, apparatus, and program for promoting the use of consumables which also identifies the source of each consumable and bases the reward on the source (rebate offer)(col 5, line 61 – col 6, line 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to identify the source in Sato and to base the reward (percentage discount) on the source. One would have been motivated to identify the source in Sato in view of Sato's disclosure of identifying the consumable cartridge by cartridge type ID and serial number (placed on the cartridge by the source/manufacture)(page 7, paragraph 0123) and to base the reward on the source in order to allow the source/manufacture to provide rebates for returning the cartridges as discussed in Wegman.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Sato et al (JP 2001-305920) is the Japanese patent of the cited reference above.

b. Nelson (5,041,851) discloses a method, apparatus, and program for promoting the use of consumables which not only tracks the use of a consumable in an imaging device, but also calculates estimates of such usage over 10 years prior to the filing date of the current application.

c. Ito (US 2002/0049638) discloses a method, apparatus, and program for promoting the use of consumables by tracking the use of consumables in an imaging device and offering a discount based on the consumption of the consumable.

d. Asauchi et al (US 2002/0091585) discloses a method, apparatus, and program for promoting the use of consumables in an imaging device and offering a discount based on the consumption of the consumable.



Art Unit: 3622

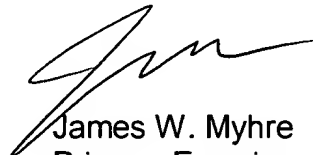
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM  
June 15, 2005



James W. Myhre  
Primary Examiner  
Art Unit 3622